

REMARKS

Claims 2, 6-9, and 21-70 are pending in this Application. The Office action mailed 23 April 2003 (Paper No. 16) relies upon the following two references:

U.S. Pat. 5,483,260	9 Jan. 1996	Parks <i>et al.</i> (Parks); and
U.S. Pat. 5,488,384	30 Jan. 1996	Uehara <i>et al.</i> (Uehara).

As shown in Paper No. 16, the status of the pending claims is as follows:

- * Claims 26-35 are rejected under 35 U.S.C. § 102(e) as being anticipated by Parks (Paper No. 16, p. 2)
- * Claims 2, 6-9, 21-25, 36-42, and 43-70 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Parks in view of Uehara (Paper No. 16, p. 3)

The present invention is intended to make a computer more convenient to use, so that a user can replace a display unit while the computer remains on. In the past, there has been a need to reboot a computer when a display unit is replaced. But the present invention sets forth a method and apparatus for replacing a display unit *without* rebooting the computer. The computer will detect the newly connected display unit and operate with the new display unit smoothly, without a need to reboot the computer.

A. PARKS '260 (U.S. Pat. No. 5,483,260)

Parks '260 is intended to eliminate a need for a floppy diskette under certain circumstances.

When a user turns off a computer and then disconnects the monitor from the main body of that computer, and then connects a new, different, monitor to the main body of the computer, the settings of the computer will need to be updated to be compatible with the new monitor. A user can insert a floppy diskette into the computer to provide information about the new monitor, so that the computer will function normally. Parks '260 is intended to eliminate the need for that floppy diskette. Thus, one purpose of Parks is to make a person's life a little bit less complicated, by eliminating a need of a diskette when installing a new computer monitor (see col. 2, lines 60-67).

Parks '260 states that "in the preferred embodiment during each POST procedure the system unit 114 receives capability information from the video monitor 116" (col. 6, lines 40-42). The POST procedure is the power on self test procedure performed when a computer is first powered on.

Also, Parks is intended to eliminate a need for a user to manually input any data about the new monitor (identifying the model, capabilities, or features of the new monitor, for example) after the new monitor is connected to a computer (see col. 6, lines 11-39). In Parks, regarding a new monitor, the "communication of capability information is preferably performed during or after each power on self test (POST) of the computer system without direct user involvement" (col. 6, lines 33-39).

Parks '260 does not expressly or inherently describe "connecting a video display unit to a computer system after said computer system has been initialized and while said computer system is

being operated by a user”.

Parks '260 does not teach or suggest “connecting a video display unit to a computer system after said computer system has been initialized and while said computer system is being operated by a user”.

B. UEHARA '384 (U.S. Pat. No. 5,488,384)

In Uehara '384, a portable computer has a flat panel display, and that portable computer can be connected to an external monitor when the portable computer is turned off. It is possible to turn off a portable computer, connect an external cathode ray tube (CRT) monitor to the portable computer, and then turn on the portable computer. Then, after a period of using the portable computer and the external CRT monitor, it is possible to turn the computer's power off for a while and to turn it back on in the “resume” mode.

Without the use of the Uehara device, when the computer is turned on using the “resume” mode, the computer will not perform a full initialization procedure relating to the monitor connected. Instead of performing a full initialization procedure relating to the monitor connected, the computer will merely read data that was stored in memory and then utilize that stored data to send data to external monitor without checking to see if that monitor is still connected. Thus, if the external CRT monitor was disconnected after the power was turned off, and then, later, the power is turned on in the resume mode, the *problem* is that the resume mode will probably fail. The computer will

probably need to be rebooted so that a full initialization procedure will be performed, relating to the flat panel display and any external monitors that might be in communication with the computer. See column 1 at lines 20-67.

The Uehara device attempts to allow a power-on in resume mode to be successful, even when the external CRT monitor was disconnected after the power was turned off. See column 2 at lines 11-35.

Uehara '384 does not expressly or inherently describe “connecting a video display unit to a computer system after said computer system has been initialized and while said computer system is being operated by a user”.

Uehara '384 does not teach or suggest “connecting a video display unit to a computer system after said computer system has been initialized and while said computer system is being operated by a user”.

C. CLAIMS 26-35 ARE NOT ANTICIPATED BY PARKS '260

The claims 26-35 are rejected under 35 U.S.C. § 102(e) as being anticipated by Parks '260 (Paper No. 16, p. 2). The Applicant respectfully believes that this rejection is improper because Parks does not describe the “connecting” set forth in lines 2-3 of claim 26 and because Parks does not describe the “connecting” set forth in lines 3-4 of claim 31.

1. Parks Fails to Describe Each and Every Element of Claims 26 and 31

Parks fails to describe **each and every element** set forth in claims 26 and 31 because the “connecting” set forth in claim 26 is not described by Parks, and because the “connecting” set forth in claim 31 is not described by Parks.

All rejections under 35 U.S.C. § 102 are subject to a stringent standard of “anticipation” which must be completely satisfied by the Examiner. “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. Inc. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Claim 26 sets forth “connecting a video display unit to a computer system after said computer system has been initialized and while said computer system is being operated by a user”. Regarding independent claim 26, Parks does not expressly or inherently describe the claimed “connecting”.

Claim 31 sets forth “connecting a video display unit to a computer system after said powering on of said computer system”. Regarding independent claim 31, Parks does not expressly or inherently describe the claimed “connecting”.

In view of the foregoing, the Applicant respectfully submits that Parks fails to describe “each and every element” as set forth in claims 26 and 31. Therefore the rejection of claims 26 and 31 is

improper. Since claims 27-30 and 32-35 depend from claims 26 and 31, respectively, the Applicant respectfully requests that the Examiner withdraw the rejection of claims 26-35.

b. Elements in Claims 26 and 31 are Absent from Parks

It is clear that elements set forth in claims 26 and 31 are **absent** from Parks, because the “connecting” set forth in claim 26 is absent from Parks, and because the “connecting” set forth in claim 31 is absent from Parks.

It is important to note that “[a]bsence from the reference of any claimed element negates anticipation.” *Kloster Speedsteel AB v. Crucible Inc.*, 230 USPQ 81, 84 (Fed. Cir. 1986).

Claim 26 sets forth “connecting a video display unit to a computer system after said computer system has been initialized and while said computer system is being operated by a user”. Regarding independent claim 26, the claimed “connecting” is absent from Parks.

Claim 31 sets forth “connecting a video display unit to a computer system after said powering on of said computer system”. Regarding independent claim 31, the claimed “connecting” is absent from Parks.

In view of the foregoing, the Applicant respectfully submits that elements set forth in claims 26 and 31 are absent from Kume. Therefore the rejection of claims 26 and 31 is improper.

Accordingly, the Applicant respectfully requests that the Examiner withdraw the rejection of claims 26-35.

2. Rejection of Claims 26-35 is Improper and Should be Withdrawn

The Applicant respectfully submits that the foregoing reasons demonstrate that the § 102 rejection of claims 26-35 is improper.

“Anticipation requires that every limitation of the claim in issue be disclosed, either expressly or under principles of inherency, in a single prior art reference.” *Corning Glass Works v. Sumitomo Electric*, 9 USPQ2d 1962, 1965 (Fed. Cir. 1989). “Anticipation requires the presence in a single prior art disclosure of all elements of a claimed invention arranged as in the claim.” *Connell v. Sears, Roebuck & Co.*, 220 USPQ 193, 198 (Fed. Cir. 1983). “A prior art disclosure that 'almost' meets that standard ... does not 'anticipate.’” *Id.* If one claimed element, no matter how insubstantial or obvious, is excluded from a prior art reference, then this is enough to negate anticipation.

Parks fails to expressly or inherently describe every feature set forth in claim 26, and, therefore, the § 102 rejection of claim 26 is respectfully believed to be improper. The claims 27-30 depend from claim 26, and, in view of this dependency, the rejections of claims 27-30 are therefore respectfully believed to be improper. The Applicant respectfully requests that the Examiner withdraw the rejections of claims 26-30.

Parks fails to expressly or inherently describe every feature set forth in claim 31, and, therefore, the § 102 rejection of claim 31 is respectfully believed to be improper. The claims 32-35 depend from claim 31, and, in view of this dependency, the rejections of claims 32-35 are therefore respectfully believed to be improper. The Applicant respectfully requests that the Examiner withdraw the rejections of claims 31-35.

D. CLAIMS 2, 6-9, 21-25, 36-70 ARE PATENTABLE OVER PARKS AND UEHARA

The Examiner rejects claims 2, 6-9, 21-25, and 36-70 under § 103 as being unpatentable over a proposed combination of Parks '260 in view of Uehara '384. The Applicant respectfully traverses the § 103 rejection of these claims because Parks in view of Uehara fail to teach or suggest the claimed features relating to coupling or connecting display units.

To establish a *prima facie* case of obviousness, for a rejection of claims under 35 U.S.C. § 103, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See MPEP §§ 706.02(j) and 2143. If the examiner fails to establish a *prima facie* case, the rejection is improper and will be overturned. *In re Fine*, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

Claim 21, for example, sets forth “connecting a video display unit to a computer system after said computer system has been powered on and initialized”. The Examiner's proposed combination of Parks '260 and Uehara '384 fails to teach or suggest these features set forth in claim 21. Nothing in Parks teaches these features of claim 21. Nothing in Uehara teaches these features of claim 21. The Examiner does not establish a *prima facie* case of obviousness regarding these features of claim 21.

Parks does not teach or suggest connecting a video display unit to a computer system after said computer system has been powered on and initialized. Uehara does not teach or suggest connecting a video display unit to a computer system after said computer system has been powered on and initialized.

The Paper No. 16 does not demonstrate how either Parks or Uehara could show these features of claim 21.

Regarding claim 2, the Examiner's proposed combination of Parks in view of Uehara fails to teach or suggest the “detecting” set forth in lines 2-3 and the “polling operation” in lines 13-14.

Regarding claim 6, the Examiner's proposed combination of Parks in view of Uehara fails to teach or suggest the “detecting” set forth in lines 2-3 and the “polling operation” in lines 13-14.

Regarding claim 7, the Examiner's proposed combination of Parks in view of Uehara fails to teach or suggest the “detecting” set forth in lines 2-3 and the “polling operation” in lines 13-14.

Regarding claim 8, the Examiner's proposed combination of Parks in view of Uehara fails to teach or suggest the “detecting” set forth in lines 2-3 and the “interrupt signal” in lines 13-14.

Regarding claim 9, the Examiner's proposed combination of Parks in view of Uehara fails to teach or suggest the “detecting” set forth in lines 2-3 and the “interrupt signal” in lines 13-14.

Regarding claim 21, the Examiner's proposed combination of Parks in view of Uehara fails to teach or suggest the “connecting” set forth in lines 2-3.

Regarding claim 36, the Examiner's proposed combination of Parks in view of Uehara fails to teach or suggest “said video display unit being connected to said computer system after said computer system has been powered on and initialized” set forth in lines 3-5.

Regarding claim 43, the Examiner's proposed combination of Parks in view of Uehara fails to teach or suggest “said video display unit being connected to said computer system after said computer system has been booted” set forth in lines 3-4.

Regarding claim 51, the Examiner's proposed combination of Parks in view of Uehara fails

to teach or suggest the claimed “hot-plugging”.

Regarding claim 52, the Examiner's proposed combination of Parks in view of Uehara fails to teach or suggest the claimed “hot-plugging”.

Regarding claim 55, the Examiner's proposed combination of Parks in view of Uehara fails to teach or suggest the claimed “hot-plugging”.

Regarding claim 56, the Examiner's proposed combination of Parks in view of Uehara fails to teach or suggest the claimed “hot-plugging”.

Regarding claim 59, the Examiner's proposed combination of Parks in view of Uehara fails to teach or suggest the claimed “hot-plugging”.

Regarding claim 60, the Examiner's proposed combination of Parks in view of Uehara fails to teach or suggest the claimed “hot-plugging”.

Regarding claim 63, the Examiner's proposed combination of Parks in view of Uehara fails to teach or suggest the claimed “hot-plugging”.

Regarding claim 64, the Examiner's proposed combination of Parks in view of Uehara fails

to teach or suggest the claimed “hot-plugging”.

Regarding claim 67, the Examiner's proposed combination of Parks in view of Uehara fails to teach or suggest the claimed “hot-plugging”.

Regarding claim 68, the Examiner's proposed combination of Parks in view of Uehara fails to teach or suggest the claimed “hot-plugging”.

If an independent claim is nonobvious under § 103, then any claim depending therefrom is nonobvious. *In re Fine*, 5 USPQ2d 1596 (Fed. Cir. 1988); MPEP § 2143.03. The Applicant respectfully submit that the foregoing reasons demonstrate that the § 103 rejection of claims 2, 6-9, 21-25, and 36-70 is improper.

When an invention is alleged to be obvious from a reference, the reference must disclose *all of the elements* of the invention. No claim limitation can be ignored in making a patentability analysis under § 102 or under § 103. *In re Lowry*, 32 F.3d 1579, 1582, 32 U.S.P.Q.2d 1031 (Fed. Cir. 1994) (“The PTO must consider all claim limitations when determining the patentability of an invention over the prior art.”). See also *Al-Site Corp. v. VSI Int'l*, 174 F.3d 1308, 1324, 50 U.S.P.Q.2d 1161 (Fed. Cir. 1999). In that case, the Federal Circuit held that a claim was not shown to be obvious from the Seaver patent. The reason was that “although the Seaver patent discloses some of the elements recited in the Magnivision patents' claims, it does not disclose the display

member, the cantilevered support, or the aperture for mounting the hanger tag on the cantilevered support,” and the art of record did not suggest adding those elements to Seaver.

The Examiner has not satisfied the requirements set forth in 35 U.S.C. § 103 regarding a rejection of claims based on obviousness. The Examiner has failed to establish the aforementioned first basic criterion of a *prima facie* case of obviousness because the Examiner failed to show that there is some suggestion or motivation, either in Parks and Uehara or in the knowledge generally available to one of ordinary skill in the art, to combine/modify the references to arrive at the Applicant's claimed invention. There is no reasonable suggestion or motivation to combine or modify Parks and Uehara to arrive at the Applicant's claimed invention.

Also, the Examiner has failed to establish the aforementioned second basic criterion of a *prima facie* case of obviousness because the Examiner failed to show that there would be a reasonable expectation of success as a result of the Examiner's proposed modification of cited art.

Furthermore, the Examiner has failed to establish the aforementioned third basic criterion of a *prima facie* case of obviousness because the Examiner failed to show that Parks in view of Uehara teaches or suggests all the claim limitations of claims 2, 6-9, 21-25, and 36-70. The Examiner has failed to establish a *prima facie* case of obviousness because the Examiner failed to show that the references teach or suggest all the claim limitations.

The foregoing shows that the Examiner has failed to establish a *prima facie* case of obviousness. In view of the noted deficiencies of Parks and Uehara, the Applicant respectfully submits that the rejection of claims 2, 6-9, 21-25, and 36-70 is improper.

Accordingly, in view of the foregoing, the Applicant respectfully requests that the claims 2, 6-9, 21-25, and 36-70 be allowed.

In view of the above, it is submitted that the claims of this application are in condition for allowance, and early issuance thereof is solicited. Should any questions remain unresolved, the Examiner is requested to telephone Applicant's attorney.

Respectfully submitted,



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